

### **REMARKS**

In the Final Office Action, the Examiner rejected claims 1-45. Applicants respectfully traverse all of the Examiner's rejections and stress that the presently pending claims are patentable over the cited references. In view of the following remarks, Applicants request reconsideration and allowance of all pending claims.

#### **Claim Rejections Under 35 U.S.C. § 103**

In the Final Office Action, the Examiner rejected claims 1-45 under 35 U.S.C. § 103(a) as unpatentable over Dunworth et al. (U.S. Patent No. 5,930,474) in view of Killcommons et al. (U.S. Patent No. 6,424,996). Claims 1, 16, 29, and 38 are independent. Applicants respectfully traverse this rejection.

#### ***Legal Precedent***

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); *see* M.P.E.P. § 2143.01. Likewise, it is improper to combine references when the combination requires substantial reconstruction or redesign of the main reference to arrive at the claimed invention. *In re Ratti*, 123 U.S.P.Q. at 349. Similarly, if a proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. M.P.E.P § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

***Features of the Independent Claim 1 Missing from the Cited Combination***

Independent claim 1 recites “the *medical locator system* is configured for multiple *modalities*, the client data comprising a desired geographic region for *locating a desired medical resource for a least one of the multiple modalities*.” Conversely, neither reference cited by the Examiner teaches a *medical locator system* configured to employ location data and other data to establish the position and availability of multiple

*modalities*, much less a desired medical resource for one of the multiple modalities. *See, e.g.,* Killcommons, col. 1, lines 22-30; col. 6, lines 44-58. Fig. 18 of Dunworth simply shows an undifferentiated list of hospitals and health services, which is typical of yellow pages as described by Dunworth. The Dunworth reference does not teach or suggest specific medical resources or different modalities, thereby precluding the possibility of locating a desired medical resource for a particular modality.

The Killcommons reference also fails to teach or suggest these claim features. The Killcommons et al. reference, for example, discloses a technique for the electronic transfer of medical information *derived* from different medical modalities, and does not even consider the type of descriptive data directed to *locating* a medical modality system. Killcommons, col. 1, lines 16-19 and 49-51 (disclosing a system for transferring patient medical information, such as clinical/parameter data). Even if Killcommons discloses multiple modalities associated with medical resources, the cited reference does not differentiate medical resources by location. As a result, even if the multiple modalities were combined with Dunworth, the system of Dunworth would be incapable of locating a desired medical resource associated with a particular one of the multiple modalities. Accordingly, claim 1 and its dependent claims 2-15 are believed to be allowable over the cited combination.

***Features of the Independent Claims 16 and 29 Missing from the Cited Combination***

In addition, the Examiner acknowledged that Dunworth et al. do not teach “a resource *locator system* configured for locating a desired medical resource,” as recited by independent claims 16 and 29. Final Office Action, page 10. As discussed above, Dunworth teaches only general topical categories, including hospitals and health services as shown in Fig. 10, which are not further differentiated or subdivided according to a desired medical resource. Indeed, the Dunworth et al. on-line yellow pages and phone/address information in no way resemble the claimed resource locator system. *See,*

e.g., Dunworth, Figures 10 and 18. Yellow pages, such as disclosed by Dunworth, provide very general information that is not indicative of specific resources, modalities, and so forth. As with typical yellow pages, a person would have to contact each one of the listed hospitals or healthcare services to determine whether a desired resource is available. Moreover, a person may not even determine whether a desired medical resource is available by a mere phone call. Telephone numbers listed in the yellow pages are typically general contact numbers, and the persons answering the phone at these numbers typically have little or no information regarding specific medical resources. Therefore, Dunworth is clearly incapable of locating a desired medical resource as recited by claims 16 and 29.

Further, Applicants strongly emphasize that the secondary reference, Killcommons et al., also does not disclose these recited claim features. Instead, Kilcommons et al. is directed to satisfying the “need for medical transfer systems that allow for transfer of complex data from a variety of modalities over email and web browser systems” without any regard to the location of resources and modalities. Killcommons, et al., col. 3, lines 52-55. The Examiner must not confuse the mere transfer of Killcommons et al. patient modality data with the presently claimed system directed to locating medical resources, e.g., in or associated with a given facility or entity. It is clear that the systems disclosed in both cited references are not configured to manage descriptive information needed or useful in locating a desired medical resource. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 16 and 29 or their respective dependent claims.

***Features of Independent Claim 38 Missing from the Cited Combination***

Claim 38 recites “searching a *medical locator database* for the at least one medical resource.” In stark contrast, both references relied on by the Examiner are absolutely devoid of a *medical locator database*. For example, Dunworth et al. discloses

a geography database, a local content database, a yellow page database, and a configuration database. *See, e.g.*, Fig. 8. The Dunworth et al. databases clearly are not configured for particular *medical resources*. Further, while the Killcommons et al. reference discloses the transfer of data from various modalities, the reference never mentions or suggests any type of data or databases regarding the location of modalities or medical resources. *See* Killcommons, Fig. 1; col. 1, lines 25-65; col. 2, lines 2-9; col. 3, lines 57-64. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 38 or its dependent claims.

***Request Withdrawal of Rejection***

In view of these deficiencies, the Dunworth et al. and Killcommons et al. references, taken alone or in combination, fail to teach or suggest each element of independent claims 1, 16, 29, and 38. Accordingly, Applicants strongly assert that the Examiner's rejection of the claims 1-45 cannot stand. Applicants respectfully request the withdrawal of the Examiner's rejection and allowance of claims 1, 16, 29, and 38, and the claims that depend therefrom.

***Features of Dependent Claims Missing from the Cited Combination***

While the dependent claims are patentable over the cited combination because of their dependency on an allowable base claim, the dependent claims are also patentable by virtue of the subject matter they separately recite.

For example, dependent claim 6 recites "receiving the *selection* from a plurality of *medical imaging systems*." Dependent claim 22 recites "a *selection* of the desired medical resource from a plurality of *medical imaging systems*. While the Killcommons et al. reference discloses various medical imaging systems, the Killcommons et al. reference does not disclose a *selection* from a plurality of medical imaging systems, or *receiving* such a selection. *See* Killcommons, col. 1, lines 49-65. Instead, Killcommons et al.

teaches transferring patient information derived from medical imaging systems, without any regard to selecting a desired medical resource from a list of medical imaging systems. *See* Killcommons, col. 1, lines 22-30; col. 6, lines 44-58. As for Dunworth et al., it is absolutely devoid of medical imaging systems, much less making or receiving a selection from a plurality of medical imaging systems. *See* Dunworth, col. 7, lines 11-16; col. 9, lines 61-63; col. 25, lines 25-27. As discussed above, the Dunworth et al. reference never goes beyond mentioning hospitals and their associated addresses and phone numbers. *See* Dunworth, Figs. 10 and 18. The cited references, taken alone or in combination, plainly do not disclose a list of medical imaging systems from which a particular imaging system may be selected to satisfy the need for a medical resource. The references clearly fail to teach a *selection* from a list of *medical imaging systems*. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 6 and 22 for this reason as well.

Dependent claim 21 recites “a *selection* of the desired *medical* resource from a *plurality of modalities*.” Dependent claim 30 recites “wherein the *query form* comprises a *field* for *selecting* the desired *medical resource* from a plurality of medical resources comprising *multiple modalities*.” Dependent claim 39 recites “a *selection* from a plurality of *medical resources* comprising *multiple modalities*.” In contrast, the cited combination does not disclose making a selection of any type of particular medical resource, much less making a selection from a plurality of modalities or multiple modalities. Likewise, neither reference discloses a query form or field for making or entering such a selection. *See* Dunworth, col. 7, lines 11-16; col. 9, lines 61-63; col. 25, lines 25-27; Killcommons, col. 1, lines 22-30; col. 6, lines 44-58. Instead, as discussed above, Dunworth et al. teach only general categories not differentiated according to a particular medical resource or modality. *See* Dunworth, Figs. 10 and 18. Killcommons et al. teach telemedicine without addressing any need for locating or selecting a medical resource. *See* Killcommons, col. 1, lines 22-30; col. 6, lines 44-58. It is clear that neither reference

provides for selecting a particular medical resource from *multiple modalities* or a *plurality of modalities*. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 21, 30, and 39 for this reason as well.

Dependent claim 27 recites “wherein the map system is remote from the resource locator system.” In stark contrast, neither reference discloses a map system, much less a map system that is remote from a locator system. While the Dunworth et al. reference discloses an image map query or image map program to initiate a geographical search of a consumer product or service, the Dunworth et al. reference in no way discloses a map system for pinpointing or mapping a location of a specific medical resource. *See* Dunworth, col. 13, lines 8-61; Fig. 4. The Killcommons et al. reference is directed to telemedicine, and clearly does not disclose mapping a geographic location of a desired medical resource. *See* Killcommons, col. 1, lines 22-30; col. 6, lines 44-58. Accordingly, the Examiner has failed to establish a *prime facie* case of obviousness with regard to dependent claim 27 for this reason as well.

#### ***No Reason to Combine References – Lack of Objective Evidence***

In addition, the Examiner did not provide objective evidence of the requisite motivation or suggestion to combine or modify the Dunworth et al. and Killcommons et al. references. Instead, the Examiner employed impermissible hindsight in modifying the Dunworth et al. general categorical on-line yellow pages with the Killcommons et al. technique of transferring patient data derived from a modality (not locating resources). *See* Final Office Action, page 3. Plainly, there is no reason to incorporate the Killcommons et al. patient information (e.g., test results, x-ray image, etc.) or its telemedicine system for transferring such information into the Dunworth et al. electronic yellow pages. Moreover, there is no reason to modify the Dunworth et al. consumer system to incorporate the present medical client data or modality location-descriptive data, or a locator system that uses/analyzes such data. The Federal Circuit has warned

that the Examiner must not, “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Dembiczak*, F.3d 994, 999, 50 U.S.P.Q.2d 52 (Fed. Cir. 1999) (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)). Applicants respectfully stress that the Examiner has not met the evidentiary requirements, i.e., *objective evidence*, for the requisite motivation or suggestion to combine the cited references in the manner asserted by the Examiner or in the manner recited by the claims. Accordingly, Applicants challenge the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references, or in the alternative, the Applicants request that the Examiner withdraw the rejection under 35 U.S.C. § 103(a) and allow the claims.

### ***Improper Combination***

Applicants stress that the Examiner’s proposed combination of Dunworth et al. and Killcommons et al. is improper and cannot stand. Indeed, a modification of the Dunworth system to include data descriptive of a location of a specific modality and/or desired medical resource would require substantial redesign of the Dunworth et al. system. See *In re Ratti*, 123 U.S.P.Q. at 249. The Dunworth et al. interface and analysis capability would require substantial redesign to locate, for example, a specific MRI machine in a given facility that matches particular client data. See e.g., Dunworth, col. Figures 10 and 18. Again, the Dunworth yellow pages provide only general addresses of hospitals and healthcare services without regard to specific resources or modalities that may or may not reside there. See e.g., Dunworth, col. 7, lines 11-16; col. 9, lines 61-63; col. 25, lines 25-27. As stated in the legal precedent section above, it is improper to combine references when the combination requires substantial redesign of the main reference. See *In re Ratti*, 123 U.S.P.Q. at 249. For these reasons, Applicants respectfully stress that Dunworth cannot be modified or combined with Killcommons as



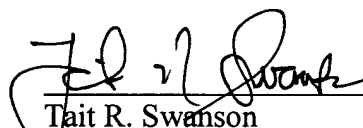
proposed by the Examiner. Accordingly, Applicants respectfully request that the Examiner withdraw the combination and allow the claims.

**Conclusion**

In view of the foregoing remarks, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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Tait R. Swanson  
Reg. No. 48,226  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545